

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1 and 16 are rejected under 35 U.S.C. 102 or 103 over the U.S. patent to Hyodo.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicant amended claim 2 to more clearly define the present invention and to distinguish it from the prior art. Claims 1 and 12-16 have been canceled and the remaining claims have been amended as well.

It is respectfully submitted that claim 2 as amended clearly and patentably distinguish the present invention from the prior art applied by the Examiner.

Claim 2 defines a power tool system which includes a power tool 14 with a receptacle region 44 for a replaceable rechargeable battery unit and a coupling unit 16, 48 which is provided for charging the replaceable rechargeable unit and is provided on the housing of the power tool 14, and a replaceable rechargeable battery unit 10 having a coupling unit 16, 48 which is provided on the housing of the power tool 14 for charging the replaceable rechargeable battery unit 10 in the mounted state on the power tool 14.

Claim 2 specifically defines that the system includes the power tool and replaceable rechargeable battery unit, and each of these two components is provided with a coupling unit for charging the battery unit, as can be clearly seen from Figure 1 of the application. One of the coupling units is located on the housing of the power tool, and another of the coupling units is located on the battery unit.

The power tool system in accordance with the present invention as explained herein above is not disclosed in the U.S. patent to Hyodo, et al. As explained in the Abstract of this reference, the battery unit 5 of the battery-charging system is contained in a grip handle of the screwdriver and has terminals 10 for recharging, which are exposed in a surface of a protrusion. The housing of the charger is provided with a first receiving recess, which can receive the nose of the screwdriver, and a second recess, which can receive the protrusion of the screwdriver. The charger further includes a pair of charge terminals that resiliently project into the second receiving recess. The charger circuit terminals are brought into electrical contact with the corresponding terminals in the protrusion of the screwdriver, when the screwdriver is set on the charger.

It is therefore clear that in the reference the screwdriver is provided with only coupling unit for charging the battery unit. The coupling unit is arranged on the battery unit itself and is exposed in a surface of a protrusion. The screwdriver however does not has a second coupling unit located on the housing of the power tool as now defined in amended claim 2.

The original claims were rejected over the patent to Hyodo as being anticipated. In connection with this, it is believed to be advisable to cite the decision in *re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the reference does not disclose each and every element of the power tool system of the present invention as now defined in claim 2.

As for the rejection of the original claims under 35 U.S.C. 103 as obvious, it is respectfully submitted that the reference does not contain any hint or suggestion for the features which are now defined in claim 2 to make them obvious. Therefore in order to arrive at the applicant's invention from the teaching of the reference, it is not sufficient for a person skilled the art to familiarize himself with the teaching of the reference, but instead the reference has to be fundamentally modified by including into it the features which were first proposed by the applicant.

However, it is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In view of the above presented remarks and amendments, it is believed that claim 2 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 2, they share its allowable features, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



Michael J. Striker
Attorney for Applicant

Reg. No. 27233